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09/610,005	07/05/2000	Jay Donahue	11684.00003	4305

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EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/610,005

Applicant(s)

DONAHUE, JAY

Examiner

Daniel L. Greene

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 09 November 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5. 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 28,43, and 47 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 28,43, and 47 all deal with a computer carrying out the steps of Claims 23 and/or 38.

Implementing the steps of Claims 23 and 38 is obvious and understood by a person of ordinary skill in the art at the time the invention was made because a “computer-assisted method of negotiating...” comprising the steps of...” and then describing steps the computer takes can only be done by a computer carrying out the steps.

2. Claim 46 is objected to because of the following informalities: Claim 46 appears to be improperly dependant on Claim 36 and should be dependant on Claim 30.

Appropriate correction is required.

### ***Specification***

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-45 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10/042245. Although the conflicting claims are not identical, they are not patentably distinct from each other because they effectively deal with the interaction of a buyer, a seller and a 3<sup>rd</sup> party for arriving at an mutually agreed upon

price through a menu driven program. Also, the manipulation and presentation of the data during the transactions prior to reaching an agreement are not novel or unique and therefore do not contribute to the patentability of the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As per Claim 1.

Application No. 10/042245 shows;

(1) displaying on a computer screen a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, wherein the plurality of lease provisions are associated with a first phase of a lease negotiation; Cl.1,1

(2) for each of a plurality of negotiators to the lease transaction, selecting one of the plurality of predefined actions associated with each lease provision; Cl.1,1

(3) for each lease provision, determining whether each of the plurality of negotiators has selected the same associated predefined action and, if so, storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non-agreed lease provisions to a later phase of the lease negotiation. Cl. 22,3.

As per Claim 2.

Application No. 10/042245 further shows;

wherein step (2) comprises the step of selecting either an AGREE choice or a DEFER choice for each lease provision. Cl.1,1.

As per Claim 3.

Application No. 10/042245 shows the claimed invention except for the wherein steps (1) and (2) are performed at a prospective tenant's computer during a first time period, and wherein steps (1) and (2) are performed at a prospective landlord's computer during a second time period.

Application No. 10/042245 teaches that it is known to wherein steps (1) and (2) are performed at a prospective purchaser's computer during a first time period, and wherein steps (1) and (2) are performed at a prospective seller's computer during a second time period. Cl. 24.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute purchaser for tenant and landlord for seller as taught by Application No. 10/042245 since each are functionally equivalent.

As per Claim 4.

Application No. 10/042245 further shows;

wherein step (2) further comprises the step of receiving from at least one of the negotiators, a numerical value pertaining to at least one of the lease provisions. Cl. 25.

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As per Claim 5.

Application No. 10/042245 further shows;

the step of converting in the computer the numerical value from a first unit of measure to a second unit of measure and displaying the second unit of measure. Cl. 26.

As per Claim 6;

Application No. 10/042245 further shows;

the step of converting in the computer the numerical value from a first unit of currency to a second unit of currency and displaying the second unit of currency. Cl. 27.

As per Claim 7.

Application No. 10/042245 shows the claimed invention except for the term "lease". Application No. 10/042245 teaches about the term "sale" in place of the term "lease". It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the term lease with the term sale as taught by Application No. 10/042245 since each are functionally equivalent.

Therefore, the step of selecting a third-party service provider from a computer database, wherein the third-party service provider is selected from a geographic area to which the lease (sale) pertains is shown in Cl. 28.

As per Claim 8.

Application No. 10/042245 shows the claimed invention except for the term "lease". Application No.10/042245 teaches about the term "sale" in place of the term "lease". It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the term lease with the term sale as taught by Application No. 10/042245 since each are functionally equivalent.

Therefore, the step of electronically transmitting to the third-party service provider a request for services pre-populated with information pertaining to the lease (sale) negotiation is shown in Cl. 29.

As per Claim 9.

Application No. 10/042245 shows the claimed invention except for the term "lease". Application No.10/042245 teaches about the term "sale" in place of the term "lease". It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the term lease with the term sale as taught by Application No. 10/042245 since each are functionally equivalent.

Therefore, the step of wherein the third-party service provider is an architect, and wherein the electronically transmitted request pertains to floors plan for the lease (sale).  
Cl. 30.



As per Claim 10.

Application No. 10/042245 further shows;  
the step of completing an evaluation form for the negotiation and generating a report based on the evaluation form. Cl. 31.

As per Claim 11.

Application No. 10/042245 further shows;  
the step of (4) in the later negotiation phase, resolving lease provisions that were deferred from the first negotiation phase. Cl. 32.

As per Claim 12;

Application No. 10/042245 further shows;  
further comprising a step of automatically generating an intermediate document that summarizes points of agreement in the negotiation. Cl. 33.

As per Claim 13.

Application No. 10/042245 further shows;  
wherein steps (1) and (2) are performed over the Internet using web browsers by negotiators located at two different locations. Cl. 34.

As per Claim 14.

Application No. 10/042245 shows the claimed invention except for the terms "tenant , landlord and lease". Application No.10/042245 teaches about the terms "buyer ,seller and sale" in place of the terms "tenant , landlord and sale". It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the term tenant with the term buyer and the term landlord with the term seller and the term lease with the term sale as taught by Application No. 10/042245 since each are functionally equivalent.

Therefore, Application No. 10/042245 shows the step of a system that facilitates the negotiation of a real estate lease(sale) between a tenant(buyer) and a landlord(seller), comprising a computer system programmed with software that generates a display of a plurality of lease(sale) provisions and a plurality of predefined actions associated with each lease (sale) provision, wherein the plurality of lease (sale) provisions are associated with a first phase of a lease (sale) negotiation; wherein the software receives choices from the tenant (buyer) and the landlord (seller) for each lease (sale) provision pertaining to one of the predefined actions and, for each lease (sale) provision, determines whether the tenant (buyer) and landlord (seller) have indicated agreement and, if so, stores in the computer an indication of the agreed lease (sale) provisions and, if not, defers non-agreed lease (sale) provisions to a later phase of the lease (sale) negotiation. Cl. 35.

As per Claim 15.

Application No. 10/042245 further shows;

wherein the software receives choices from the tenant (buyer) located at a first computer during a first time period and receives choices from the landlord (seller) located at a second computer during a second time period. Cl. 36.

As per Claim 16.

wherein the software converts a numerical value relating to one of the lease (sale) provisions from a first unit of measure to a second unit of measure. Cl. 37.

As per Claim 17.

Application No. 10/042245 further shows;

wherein the software converts a numerical value relating to one of the lease (sale) provisions from a first unit of currency to a second unit of currency.

18. The system of claim 14, wherein the software suggests a third-party service provider from a computer database based on the geographic area of the lease. Cl. 38.

As per Claim 19.

Application No. 10/042245 further shows;

wherein the software electronically transmits to the third party service provider a request for services pre-populated with information pertaining to the lease (sale) negotiation. Cl. 40.

As per Claim 20.

Application No. 10/042245 further shows;

wherein the software receives evaluation information from the tenant (buyer) and the landlord (seller) and generates a report based on the evaluation information. Cl. 41

As per Claim 21.

Application No. 10/042245 further shows;

wherein the software prompts the tenant (buyer) and landlord (seller) to resolve in a later negotiation phase lease (sale) provisions that were deferred from an earlier phase. Cl. 42.

As per Claim 22.

Application No. 10/042245 further shows;

wherein the software automatically generates an intermediate document that summarizes points of agreement in the negotiation. Cl. 43.

As per Claim 23.

Application No. 10/042245 further shows;

(1) displaying on a first computer display device a plurality of lease (sale) provisions and a plurality of predefined actions associated with each lease (sale)

provision, and receiving from a first party information selecting one of the predefined actions for each lease (sale) provision; Cl. 44, 1.

(2) displaying on a second computer display device the plurality of lease (sale) provisions and the plurality of predefined actions associated with each lease (sale) provision, and receiving from a second party information selecting one of the predefined actions for each lease (sale) provision; Cl. 44,2.

(3) determining those lease (sale) provisions for which the first and second parties have selected the same predefined action; Cl.44,3. and

(4) for those lease (sale) provisions for which the first and second parties have not selected the same predefined action, assisting the first and second parties in reaching agreement. Cl. 44,4

As per Claim 24.

Application No. 10/042245 further shows;

wherein step (4) comprises the step of generating a request for services from a local service provider. Cl. 45.

As per Claim 25.

Application No. 10/042245 further shows;

the step of converting a value associated with one of the lease (sale) provisions from a first unit of measure to a second unit of measure and displaying the second unit of measure. Cl. 46.

As per Claim 26.

Application No. 10/042245 further shows;

wherein step (4) comprises the step of suggesting a value for a lease (sale) provision that is a compromise between a value offered by the first party and a value offered by the second party. Cl. 47.

As per Claim 27.

Application No. 10/042245 further shows;

the step of preventing the first party and the second party from modifying any lease (sale) provision for which the parties have selected the same predefined action. Cl. 48.

As per Claim 28.

Application No. 10/042245 further shows;

A computer-readable medium comprising computer instructions that, when executed by a computer, perform the steps recited in claim 23. Cl. 49.

As per Claim 29.

Application No. 10/042245 further shows;

(1) displaying on a first computer display device a plurality of lease (sale) provisions and a plurality of predefined actions associated with each lease (sale)

provision, and receiving from a first party information selecting one of the predefined actions for each lease (sale) provision; Cl. 50,1.

(2) displaying on a second computer display device the plurality of lease (sale) provisions and the plurality of predefined actions associated with each lease (sale) provision, and receiving from a second party information selecting one of the predefined actions for each lease (sale) provision; Cl. 50,2.

(3) negotiating between the first and second parties to reach agreement on at least one of the lease (sale) provisions for which the first and second party did not reach agreement; Cl. 50,3.

(4) receiving from each party an evaluation form including information relating to the lease (sale) negotiation process; Cl. 50,4. and

(5) generating a report including information received from the evaluation form.  
Cl. 50,5.

As per Claim 30.

Application No. 10/042245 further shows;

(1) displaying on a computer screen a plurality of predefined real estate agreement provisions each relating to one aspect of a potential real estate agreement, each provision having an associated displayed choice including at least an agreement choice and a deferral choice; Cl. 51,1.

(2) for each of a plurality of negotiators to the real estate agreement, detecting each negotiator's computer selection of one of the plurality of displayed choices for each of the predefined real estate agreement provisions; Cl. 51,2.

(3) for each predefined real estate agreement provision, determining whether each of the plurality of negotiators has selected the same displayed choice and, for each such same choice, storing in a computer an indication of agreement regarding the associated agreement provision. Cl. 51,3.

As per Claim 31.

Application No. 10/042245 further shows;

wherein each of the predefined real estate agreement provisions relates to a real estate lease provision. Cl.58.

As per Claim 32.

Application No. 10/042245 further shows;

wherein step (1) Claim 30, comprises the step of displaying the predefined real estate agreement provisions grouped into distinct negotiation phases.



As per Claim 33.

Application No. 10/042245 further shows;

wherein step (1) is performed on two computers each located at a different geographic location, wherein each negotiator selects choices during different time periods. Cl.52.

As per Claim 34.

Application No. 10/042245 further shows;

The computer-assisted method of claim 30, wherein steps (1) to (3) are performed during a first negotiation period, and further comprising the steps of:

(4) during a later negotiation period, re-displaying real estate agreement provisions for which agreement was not reached during the first negotiation period, and repeating steps (2) and (3) for all such provisions. Cl. 53.

As per Claim 35.

Application No. 10/042245 further shows;

The computer-assisted method of claim 30, wherein step (1) comprises the step of displaying each of the plurality of real estate agreement provisions simultaneously on a single computer screen. Cl. 54.

As per Claim 36.

Application No. 10/042245 further shows;

wherein step (1) of Claim 30 comprises the step of displaying each of the plurality of real estate agreement provisions successively on separate computer screens. Cl. 52.

As per Claim 37.

Application No. 10/042245 further shows;

A computer programmed with computer software that carries out steps (1) to (3) of claim 36. Cl. 49.

As per Claim 38.

Application No. 10/042245 further shows;

(1) displaying on a first computer screen a plurality of predefined agreement provisions each relating to one aspect of a potential agreement, each provision having an associated displayed choice including at least an agreement choice and a deferral choice; Cl.15, 1

(2) detecting a first negotiator's computer selection of one of the plurality of displayed choices for each of the predefined agreement provisions; Cl.15, 2.

(3) displaying on a second computer screen the plurality of predefined agreement provisions displayed on the first computer screen and a second plurality of associated displayed choices including at least an agreement choice and a deferral choice; Cl. 15,3

(4) detecting a second negotiator's computer selection of one of the plurality of displayed choices displayed on the second computer screen; Cl. 15, 4.

(5) determining whether the first and second negotiators have selected a same displayed choice for each predefined agreement provision and, for each such same choice, storing in a computer memory an indication of agreement regarding the associated agreement provision. Cl. 22,3.

As per Claim 39.

Application No. 10/042245 further shows;

the step of displaying the predefined agreement provisions grouped into distinct negotiation phases. Cl.15, 7.

As per Claim 40.

Application No. 10/042245 further shows;

the step of further displaying on the second computer screen one or more computer selections made by the first negotiator. Cl. 15, 3.

As per Claim 41.

Application No. 10/042245 further shows;

The computer-assisted method of claim 38, wherein step (1) is performed on two computers each located at a different geographic location, wherein each negotiator selects choices during different time periods. Cl. 24.

As per Claim 42.

Application No. 10/042245 further shows;

The computer-assisted method of claim 38, wherein steps (1) to (4) are performed during a first negotiation period, and further comprising the steps of:

(6) during a later negotiation period, re-displaying agreement provisions for which agreement was not reached during the first negotiation period, and repeating steps (1) through (4) for all such provisions. Cl.53.

As per Claim 43.

Application No. 10/042245 further shows;

A computer programmed with computer software that carries out steps (1) to (5) of claim 38. Cl. 49.

As per Claim 44.

Application No. 10/042245 further shows;

if the first ancillary value and the second ancillary value are different, generating a message identifying a discrepancy. Cl.9.

As per Claim 45.

Application No. 10/042245 further shows;

The computer-assisted method of claim 38, wherein step (2) comprises the step of receiving a first ancillary value from the first negotiator representing a first proposed contract value corresponding to one of the predefined agreement provisions; wherein step (4) comprises the step of receiving a second ancillary value from the second negotiator representing a second proposed contract value corresponding to one of the predefined agreement provisions; wherein the method further comprises the step of

(6) if the first ancillary value and the second ancillary value are different, proposing a third ancillary value representing a compromise between the first ancillary value and the second ancillary value. CL. 47.

As per Claim 46.

Application No. 10/042245 further shows;

A computer readable medium storing computer readable instructions that, when executed by a processor, cause a computer to perform steps (1) to (3) of claim 36. Cl. 49.

As per Claim 47.

Application No. 10/042245 further shows;

A computer readable medium storing computer readable instructions that, when executed by a processor, cause a computer to perform steps (1) to (5) of claim 38. Cl.

49.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703.306.5539. The examiner can normally be reached on M-Thurs. (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703.305.9768. The fax phone numbers for the organization where this application or proceeding is assigned are

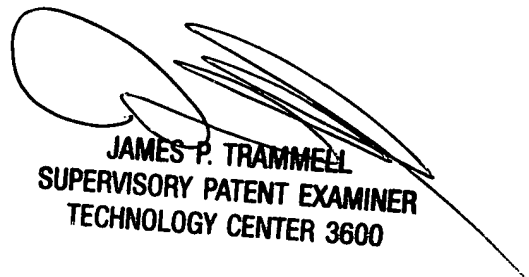
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703.305-7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308-1113.

DLG  
February 12, 2003



**JAMES P. TRAMMELL**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**